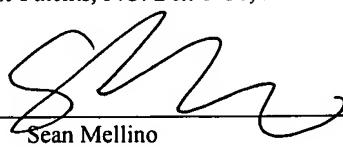


CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class mail in an envelope addressed: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450, on the date noted below:

Date: March 11, 2010



Sean Mellino

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Stefan Bracht
Serial No. : 10/553,708 (Conf. No. 5800)
Filing Date : June 16, 2006
Examiner : Isis A.D. Ghali
Group Art Unit : 1611
Title : MEDICAL ACTIVE SUBSTANCE PATCH WITH
REDUCED OPTICAL CONSPICUOUSNESS ON THE
SKIN
Attorney File : RO4101US (#90568)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Reply to Office Action Issued February 23, 2010

Dear Sir:

Claims 1-15 are pending in the instant application. The Examiner has concluded that restriction to one of the following groups is necessary:

Group I - Claims 1-10 and 12-14, drawn to a medical active substance patch comprising a matrix of monolayer or multilayer configuration and a backing layer connected with said matrix, said backing layer having one side averted from the skin, wherein at least one matrix contains an active substance, and wherein at least

one layer of the matrix contains at least one colored ingredient which is colorless is an initial state and which has a tendency to discolor or which discolor(s) during storage or during the application period; said active substance patch being transparent or translucent; said active substance patch comprises at least one substance selected from the group consisting of dyes and pigments in at least one of said layers in the state of having been applied to a first person's skin, at a place of the skin covered with the patch, has a lightness color value L1 which is not less than 50% and not more than 200% of a lightness color value L2, with L2 being the lightness value of the region of the skin of the same person which surrounds the applied patch, and that the same applies in respect of the skin of a second or any other person, provided that L2 is in the range from 5° to 100°.

Group II – Claims 11 and 15, drawn to a process for the production of an active substance patch comprising the following steps: (a) producing a system comprising a mono- or multilayer active substance-containing matrix and a backing layer connected with said matrix, wherein the matrix is produced using a matrix polymer or matrix polymers, an active substance or active substances and auxiliary agents, and wherein at least one of said matrix and said backing layer comprises at least one or more substance(s) selected from the group consisting of dyes and pigments, (b) producing at least one further system according to step (a), this system being different in terms of the concentration of the dyes and/or pigments, and/or in terms of the type of the dyes and/or pigments used; (c) producing surface sections or punched pieces from the systems obtained in steps (a) and (b); (d) producing or providing color charts having lightness color values L2 in the range from 5° to 100°; (e) applying or affixing the sections or systems obtained in step (c) to the color charts mentioned in step (d); (f) measuring the color values of the lightness L1 of the systems located on the color charts and determining the difference between L2 and L1 in each particular case; and (g) selecting those systems with a color value of the lightness L1 which is not less than 50% and not more than 200% of the lightness color value L2.

The Examiner also states in the Office action that the application contains claims directed to more than one species of the generic invention and that these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner states that the species are as follows:

- a) coating of lacquer covering the surface of the backing averted from the skin;

- b) the surface of the backing that is averted from the skin has reduced reflection properties accomplished by physical methods; or
- c) the surface of the backing has an antireflection layer applied on the surface that is averted from the skin.

The Examiner thus states that the Applicant is required to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable and that the claims are deemed to correspond to the species listed above in the following manner:

Species (a) – claims 4 and 13

Species (b) – claims 5 and 6

Species (c) – claims 7 and 8.

In addition, the Examiner states that claim 1 is generic.

The Examiner further states that the aforementioned species do not relate to a single general inventive concept under PCT Rule 13.1 because the species lack the same or corresponding special technical features since the coating of lacquer is distinguished from dyes and pigments, and both are distinguished from physical methods that may be the aluminum layer. The Examiner thus concludes that restriction in this application is proper.

The Applicant responds to the instant restriction requirement, *with traverse*. Nevertheless, the Applicant hereby elects the claims of Group I (which reads on claims 1-10 and 12-14). As noted above, the Examiner has referred to PCT Rule 13.1 in this Office action. However, the Applicant respectfully submits that the present claims meet the requirements of PCT Rule 13.2 according to which the requirement of unity of

invention is met when there is a technical relationship among the inventions involving one or more of the same or corresponding special technical features. Independent method claim 11 references claim 1, thus involving the same technical features as claim 1.

In addition, the Applicant notes that the Examiner indicated that the present application contains claims directed to more than one species of the generic invention, the species being (a) coating of lacquer (claims 4, 13), (b) the surface of the backing that is averted from the skin has reduced reflection properties (claims 5, 6) and (c) the surface of the backing has an antireflection layer applied on the surface that is averted from the skin (claims 7 and 8). In this regard, the Applicant elects species (a) – coating of lacquer (claims 4, 13).

The Examiner is invited to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

Date: March 10, 2010

By: 
D. Peter Hochberg
Reg. No. 24,603

D. Peter Hochberg Co., L.P.A.
1940 E. 6th St. – 6th Floor
Cleveland, OH 44114-2294
(216) 771-3800
DPH/SM